

## **REMARKS**

### **Amendments to the claims.**

Claim 1 is amended to specific the method for the production of the catalyst is done in at least two steps. Support for the production of the catalyst is found on page 11, line 15-22; and as exemplified in the working examples. The method for producing the catalyst is further supported by original claim 12.

Claim 14 is amended to replace the epoxide reactive moiety with 'n alcohol, amine, thiol or carboxylic acid moiety' to provide a proper antecedent bases from claim 1.

Claims 19 and 22 are cancelled.

Claim 22 is indicated as withdrawn due to the prior restriction.

The remaining claims are amended to specify a method for the production of the catalyst.

### **Restriction and withdrawal of claims 16-17, 24-33.**

The Office Action indicates claims 16 and 17 are viewed as withdrawn. Claims 16 and 17 constitute a catalyst having an imine linkage and tertiary amino group and Applicants asset they should remain under consideration, particularly based on the comments presented herein.

### **Rejection under 35 USC §112**

Claims 14 and 19 are rejected 35 USC §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Claim 14 is amended to provide a proper antecedent bases and claim 19 is cancelled.

### **Rejection under 35 USC §102**

Claims 1, 6-7, 14, 15 and 18 are rejected under 35 USAC 102(a) and 102(e) as allegedly being anticipated by Schile (US 2003/01871550). This rejection is respectfully traversed.

Schile is cited as disclosing an adduct by reacting 1 mole salicylaldehyde with 1 mole N,N(dialkylamine)-3-propylamine, resulting in a shift base [0132]. Such an adduct (hardener) may be combined with an epoxy to form an epoxy-hardener system.

As Schile discloses components as those disclosed in the present application, *In re Thorpe*, 227 USPQ 964, 966, is cited to state the patentability of a product does not depend on its

method of production if the product in the product-by-process claim is the same or obvious from a product of the prior art.

The claims of the present application are amended as given above to a method for the production of the catalyst. In particular, the order of reacting the components in Schile is distinctly different from the present claims. In Schile, salicylaldehyde is first reacted with an amine. This is followed by reaction of such an adduct with an epoxy. Based on the reaction kinetics of the system, the epoxy is expected to react with hydroxyl functionality of the adduct as well as some reaction with the tertiary amine and Schiff base. The process described in Schile would therefore produce a mix of different materials. In contrast to Schile, by way of illustration of the present invention, when salicylaldehyde is first reacted with an epoxy, the reaction will be essentially between the epoxy and the hydroxyl group of the salicylaldehyde. Subsequent addition of the amine will result in a reaction essentially of the primary amine with the aldehyde group on the salicylaldehyde. The importance of the method of making the product is illustrated by the *In re Thorpe* case where the method claims were patentable.

**Rejection under 35 USC §103(a)**

Claim 7 is further rejected under 35 USC §103(a) to as it is alleged the 3-(dimethylamino)-propylamine would have been obvious in view of Schile disclosing N,N-diethyl-3-aminiopropylamine as there is difference of only a methyl group. In view of the amendments above to a method of producing a catalyst, Applicants assert this rejection is moot.

**SUMMARY**

In view of the above amendment, applicant believes the pending application (claims 1, 6-7, 14-18, 22-24) is in condition for allowance.

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Respectfully submitted,

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